

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Jan BERKA, *et al.* CONFIRMATION NO. : 6163
SERIAL NUMBER : 10/767,899 EXAMINER : David C. THOMAS
FILING DATE : January 28, 2004 ART UNIT : 1637
PATENT NUMBER: 7,842,457 ISSUE DATE: November 30, 2010
FOR : **BEAD EMULSION NUCLEIC ACID AMPLIFICATION**

Via EFS

**REQUEST FOR RECONSIDERATION OF PATENT TERM INDICATED
ON FACE OF PATENT UNDER 37 C.F.R. §1.705(d)**

U.S. Patent No. 7,842,457 issued on November 30, 2010 from the above referenced application. The face of the patent indicates that the patent term adjustment is 413 days. Applicants hereby respectfully request reconsideration of the patent term adjustment. Specifically, Applicants believe that the total patent term adjustment should be 427 days.

In support of this request, Applicants submit the following statement of facts pursuant to 37 C.F.R. §1.705(b).

- (i) The adjustment under 35 U.S.C. §154(b)(1)(A), for failure of the Office to take certain actions within specified time frames, is 519 days.
- (ii) The correct reduction of patent term under 35 U.S.C. §154(b)(2)(C), for Applicants' failure to engage in reasonable efforts to conclude prosecution of the application, is 325 [104 + 40 + 21 + 40 + 28 + 76 + 16 = 325] days.

Applicant requests reconsideration of the patent term adjustment under 37 C.F.R. §1.705(d) to credit Applicant for 14 days of delay that the Office incorrectly attributed to Applicant under 37 C.F.R. §1.704. Specifically, the Information Disclosure Statement filed on September 9, 2010 ("the IDS") included a statement under Sections 1.704(d). Applicant hereby reiterates that each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart application and the communication was not received by any individual designated in Section 1.56(c) more than 30 days prior to the filing of the IDS. Accordingly, no delay should have been attributed to Applicant for the filing of this IDS.

(iii) The correct patent term adjustment calculated under 35 U.S.C. §154(b)(1)(B) is 1402 days, due to the failure of the Office to issue a patent within three years after the date on which the application was filed, but not including any overlap with the period in (i) and excluding the period, if any, from the date a Request for Continued Examination (“RCE”) was filed to the issue date. This application was filed on January 28, 2004 and issued on November 30, 2010. Under §154(b)(1)(B), the patent should have issued on or before January 28, 2007, a delay of 1402 days (the period from and including January 29, 2007, which is the date that is the day after the three year anniversary of filing, to the issue date, November 30, 2010). Applicants filed an RCE on September 19, 2007. The period from September 19, 2007 to the issue date, November 30, 2010 (1169 days), is excluded from the period under §154(b)(1)(B) according to the rule in 37 C.F.R. 1.703(b)(1). Thus, the correct patent term adjustment calculated under §154(b)(1)(B) is 233 days ($1402 - 1169 = 233$ days).

The adjustment sought under 37 C.F.R. §1.703(f) is the sum of the non-overlapping periods under §154(b)(1)(A) (519 days) and §154(b)(1)(B) (233 days), less the delays attributable to Applicants (325 days), or 427 days.

According to the Federal Circuit’s ruling in *Wyeth v. Kappos* (“Kappos”), no overlap can occur between the §154(b)(1)(A) and §154(b)(1)(B) periods before the time that is 3 years after the filing date of the application in the United States (“the 3-year mark”). This is because the period of §154(b)(1)(B) does not begin until the 3-year mark. Applicants have used the sum of the non-overlapping periods of §154(b)(1)(A) and §154(b)(1)(B), in accordance with the meaning of “overlap” as defined by the by the Federal Circuit in *Kappos*, to calculate the patent term adjustment due for this application.

Applicants note that the above-identified application is not subject to a terminal disclaimer. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. §1.704, other than the circumstances of record.

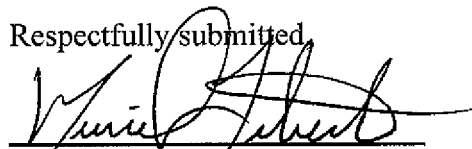
In summary, Applicants respectfully request an adjustment of patent term under 37 C.F.R. §1.703 to indicate a total PTA of 427 days. Pursuant to 37 C.F.R. §1.705(d) and §1.18(e), the fee

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Attorney Docket No.: 21465-508001US

required for filing this application for patent term adjustment is believed to be **\$200.00**. Please charge the required fee, and any additional fees due, or credit any overpayment of same, to Deposit Account Number: **50-0311**, Customer Number: **35437**, Reference Number: **21465-508001US**.

Respectfully submitted,



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